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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,768	01/22/2004	Thomas C. Adams	SC 040 CIP	3111

7590 11/01/2006  
Guy McClung  
16690 Champion Forest Drive  
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EXAMINER

KOHNER, MATTHEW J

ART UNIT PAPER NUMBER

3653

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/762,768

Applicant(s)

ADAMS ET AL.

Examiner

Matthew J. Kohner

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 21-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Specification*

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Due to the newly added claims and the cancellation of the original claims, the title, "METHODS FOR SEALING SCREEN ASSEMBLIES ON VIBRATORY SEPARATORS" no longer corresponds to the claimed invention.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,372,260 to Galton et al. (*hereinafter* "Galton").

Galton discloses a screen assembly (30) for releasable mounting to a mounting structure (17) of a screening system, the mounting structure comprising a body over which a screen assembly is positionable, at least one upwardly projecting member (40) projecting upwardly from the body, said at least one upwardly projecting member sized and configured so it is

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receivable in a corresponding hole in the screen assembly, said at least one projecting member having a projecting member cross-sectional area, the screen assembly (30) comprising:

a support (See Fig 1);

the support comprising a frame (30) with two spaced-apart ends the two spaced-apart ends spaced-apart by two spaced-apart sides, each of the two spaced-apart sides connected to each of the two spaced-apart ends, the frame having a plurality of spaced-apart cross members extending between the two spaced-apart sides from one side to the other side at least part of the frame comprising a tubular member (64) with a top and a bottom, a portion of the screening material on top of the tubular member, at least one hole (66) in the bottom of the tubular member, said at least one hole sized, configured, and located for receiving said at least one upwardly projecting member (40) of the body of the mounting structure (see Fig. 7), said at least one hole having a hole cross-sectional area greater than said projecting member cross-sectional area.

While Galton does not specifically disclose a shale shaker, Galton does disclose this locking method applies to various screening decks (col. 1, lines 20-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used Galton's locking pin method in a shale shaker.

In regard to claims 22 and 24, Galton does not specifically disclose a shale shaker with a screen mounting basket and a vibrating apparatus. However, Galton does disclose this locking method applies to various screening decks (col. 1, lines 20-22). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used Galton's locking pin method in a shale shaker. Further, many screening devices apply vibration in order to screen

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material. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used Galton's locking pin method in a screener with a vibrating apparatus.

In regard to claim 23, the hole is in the bottom of the tubular member (see Fig. 7).

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 21 and 22 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 14 and 15, respectively, of prior U.S. Patent No. 6,769,550. This is a double patenting rejection.

Claims 14 and 15 of the '550 patent recite the term "body member" in the preamble. Claims 21 and 22 of the present application recite the term "body" in place of the term "body member." The scope of these claims is identical. There does not appear to be any significant difference between the two terms. Further, the patented claim 14 recites "*the* body member" in line 6. The term "body member" is not used in the previous 5 lines of the claim. Only the term "body" is used in the previous 5 lines. Therefore, if the term "body member" did not refer to the

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same element as "body" there would have been an antecedent basis issue during prosecution of the patent. The same issue is also in patented claim 15.

### ***Response to Arguments***

Applicant's arguments filed 8/14/06 have been fully considered but they are not persuasive. Applicant has not argued the claims on the merits in regard to this Examiner's rejection in the office action of July 21, 2006. Applicant's only argument is essentially that because the Galton reference was considered and similar claims found allowable in a previous application of a related patented case, these claims should be allowable. Examiner disagrees. Examiner is not bound by the determination of previous case. Examiner has considered the Galton reference and feels the claims read on the prior art.

### ***Terminal Disclaimer***

The terminal disclaimer filed on 8/14/06 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of US Patent No. 6,769,550 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew J. Kohner whose telephone number is 571-272-6939. The examiner can normally be reached on Mon-Fri 9-5:30.

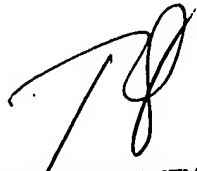
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew J. Kohner  
Examiner  
Art Unit 3653

mjk



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